

REMARKS

Claims 1-52 remain pending in the application. In the Office Action of December 2, 2004, the Examiner required restriction to one of the following inventions:

- I. Claims 1, 25-28, 41-44 and 50-52;
- II. Claims 2, 4 and 22;
- III. Claims 3, 19-21, 23, 24, 40 and 45-48;
- IV. Claims 5 and 6;
- V. Claims 7-18; and
- VI. Claims 29-39 and 49.

Applicants respectfully traverse the Examiner's restriction requirement for the following reasons.

The two criteria for a proper restriction requirement between patentably distinct inventions are that the inventions are independent or distinct as claimed, and there is a serious burden on the examiner. See M.P.E.P. § 803. Inventions are distinct as combination and subcombination only if it can be shown that the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and the subcombination can be shown to have utility either by itself or in other and different relations. See M.P.E.P. § 806.05(c).

In the Office Action, the Examiner identified Invention I as a combination, and Inventions II-VI as subcombinations thereof. Invention I comprises claim 1, which recites a transmitting and receiving system comprising a transmitting apparatus and a receiving apparatus. Invention II comprises claim 2, which recites a transmitting apparatus. Since the transmitting

apparatus claimed in claim 1 requires all of the claimed features of the transmitting apparatus of claim 2, Applicants respectfully submit that claims 1 and 2 are not distinct as combination and subcombination.

Invention III comprises claim 3, which recites a receiving apparatus. Since the receiving apparatus claimed in claim 1 requires all of the claimed features of the receiving apparatus of claim 3, Applicants submit that claims 1 and 3 are also not distinct as combination and subcombination.

Invention IV comprises claim 6, which recites a readable recording medium that stores a program for selecting a storage medium for accumulating data, based on a storage identifier received by a receiving apparatus. For inventions to be distinct as combination and subcombination, the subcombination must have utility either by itself or in other and different relations, and the Examiner has the burden to suggest an example of separate utility. See M.P.E.P. § 806.05(c).

Applicants note that the Examiner has stated that Invention IV has separate utility such as “a storage method and a readable recording medium,” but this statement merely recites the nature of the invention and does not suggest an example of the invention’s utility. Furthermore, Applicants respectfully submit that Invention IV does not have a utility separate from Invention I, since Invention IV is drawn to a program that requires the transmitting and receiving system of Invention I. Therefore, Applicants respectfully submit that Inventions I and IV are also not distinct as combination and subcombination.

Invention V comprises claim 7, which recites a management apparatus for use in a transmitting and receiving system comprising a transmitting apparatus, a receiving apparatus, and a management apparatus. Applicants note that a combination is an organization of which a

subcombination is a part. See M.P.E.P. § 806.05(a). Since Invention I comprises claim 1, which does not include a management apparatus, the invention recited in claim 7 cannot be a subcombination of the invention recited in claim 1. Furthermore, the invention recited in claim 7 includes all of the features recited in claim 1. Therefore, Applicant submit that Inventions I and V are also not distinct as combination and subcombination.

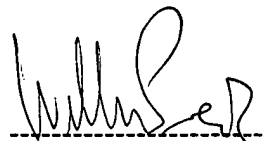
Yet further, if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on its merits. Although a serious burden on the Examiner may be prima facie shown if the Examiner shows by appropriate explanation of separate classification a different field of search, the prima facie showing may be rebutted by appropriate showings by the Applicant. See M.P.E.P. § 803. In the Office Action, the Examiner asserted that Inventions I-VI are classified in six separate classes. However, Applicant respectively submits that it would be equally appropriate to classify Inventions I-V in Class 455, Subclass 70 (Transmitter and Receiver at Separate Stations – Receiver control signal originates at message transmitter). Furthermore, one would expect the Examiner to search each of the Class 455 subclasses mentioned in the Office Action (subclasses 3.01, 70, 92, 130, 414.3) in order to do a thorough examination of any single one of Inventions I-VI. Since the search required for each of Inventions I-VI is largely co-extensive, if not exactly the same, Applicants respectfully submit that there is not a serious burden on the Examiner to examine the entire application.

For the foregoing reasons, Applicants believe the Examiner's restriction requirement is improper and respectfully request that it be reconsidered and withdrawn. Nevertheless, in order to be fully responsive, Applicants have elected with traverse, Invention II, comprising claims 2, 4

and 22, in the event that the Examiner chooses not to reconsider and withdraw the restriction requirement.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Takumi IKEDA et al.



Bruce H. Bernstein
Reg. No. 29,027

William Pieprz
Reg. No. 33,630

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GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191